



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,527	09/30/2005	Udo Merker	100717-677-WCG	6199
27386 7590 12/17/2008 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER NGUYEN, KHANH TUAN				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,527

Applicant(s)

MERKER ET AL.

Examiner

KHANH T. NGUYEN

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 38-75 is/are pending in the application.
- 4a) Of the above claim(s) 15-35 and 38-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Final

Claim Status

1. Claims 1-14 are currently pending in the instant application. Non-elected claims 15-35 and 38-75 have been withdrawn from further consideration. Claims 36 and 37 have been canceled.
2. This application contains claims 15-35 and 38-75 drawn to an invention nonelected with traverse in the reply filed on 04/10/2008. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Maintained Rejection(s)

3. The rejection of claims 1-14 under 35 U.S.C. 102(a) as being anticipated by U.S. Pub. 2002/0077450 A1 (Kirchmeyer) is maintained for the reasons set forth therein. The rejection of claims 1-9, 11, 12 and 14 under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. 7,112,368 B2 (Hsu) is maintained for the reasons set forth therein.

(Previously Rejected)

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-14 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Pub. 2002/0077450 A1 (Kirchmeyer).

Kirchmeyer discloses a process for preparing an oxidant for the preparation of conductive polymers, wherein a metal salt of an organic acid or an inorganic acid containing one or more sulfonic acid radicals (e.g. iron(III) toluenesulfonate salt) [0032-0035] is treated with an anion exchanger (e.g. Lewatit® MP 62) [0048] to remove metal ions [0041] in the presence of organic solvents such as methanol, ethanol and butanol [0037]. Kirchmeyer also discloses solvent may contain up to about 5% by weight of water [0036]. Kirchmeyer discloses the solution of oxidant is separated from the solvent by filtration after treatment with ion exchanger to obtain a clear dark-blue solution [0047-0048]. The clear dark-blue oxidant-containing solution may further be diluted (i.e. redissolved) with ethanol [0048]. Please note that the optional redissolving step is not required by the reference to be anticipatory.

The reference specifically or inherently meets each of the claimed limitations in their broadest interpretations. The reference is anticipatory.

6. Claims 1-9, 11, 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. 7,112,368 B2 (Hsu).

Hsu discloses a process for preparing an oxidant for the preparation of conductive polymers by oxidative polymerization, wherein a metal salt of an organic acid or an inorganic acid containing one or more sulfonic acid radicals (e.g. iron(III) p-

toluenesulfonate salt) (Col. 3, lines 23-37) is treated with an anion exchanger (e.g. Lewatit® MP 62) to quench the polymerization and remove metal ions (Col. 3, lines 56-60 and Col. 8, lines 40-41) in the presence of water or organic polar or non-polar solvents (Col. 4, lines 62-65). Hsu discloses the oxidant-containing polymer solution of is separated from the solvent by filtration after treatment with ion exchanger (Example 1). Please note that the optional redissolving step is not required by the reference to be anticipatory.

The reference specifically or inherently meets each of the claimed limitations in their broadest interpretations. The reference is anticipatory.

Response to Arguments

7. Applicant's arguments filed 10/06/2008 have been fully considered but they are not persuasive.

In responses to Applicant's remark on pages 2 to 3, Applicant argues that U.S. Pub. 2002/0077450 A1 to Kirchmeyer failed to suggest or teach an "oxidant being used for the preparation of conductive polymers be treated with an ion exchanger before being mixed with precursors for the preparation of conductive polymers." Similarly, at page 4 of Applicant's remark, Applicant argues that U.S. Pat. 7,112,368 B2 to Hsu failed to suggest or teach an "oxidant being used for the preparation of conductive polymers be treated with an ion exchanger before being mixed with precursors for the preparation of conductive polymers." Therefore, the rejections should be withdrawn. The Examiner respectfully disagrees with the Applicant's argument.

Claim 1 requires: "*Process for preparing an oxidant for the preparation of conductive polymers, wherein a metal salt of an organic acid or an inorganic acid having organic radicals is treated with an ion exchanger.*" **Nowhere in the instant process claim require a step of treating an oxidant with an ion exchanger before being mixed with the precursors.** The said process claim in its broadest interpretation only requires a metal salt of an organic acid or an inorganic acid having organic radicals to be treated with an ion exchanger. The claim does not specify or require treating an oxidant with an ion exchanger before being mixed with precursors as argued. Therefore, neither Kirchmeyer nor Hus needs to teach or suggest treating an oxidant with an ion exchanger before being mixed with precursors to anticipate the instant claims.

Applicant further pointed to Example 2 and Example of the present application to argue that the claimed process produce unexpected advantages, e.g. pot life and conductivity, over the processes of Kirchmeyer and Hus. The Examiner respectfully disagrees with the Applicant argument.

The process produce of Example 2 and Example 3 of the present application were compared to a process produce wherein an oxidant has not been treated with an ion exchanger and precursor whereas Kirchmeyer teaches a metal salt of an organic acid or an inorganic acid containing one or more sulfonic acid radicals (e.g. iron(III) toluenesulfonate salt) [0032-0035] which is the same or substantially similar to the metal salt as claimed that is treated with an anion exchanger (e.g. Lewatit® MP 62) [0048]. Similarly, Hus teaches a metal

salt of an organic acid or an inorganic acid containing one or more sulfonic acid radicals (e.g. iron(III) p-toluenesulfonate salt) (Col. 3, lines 23-37) is treated with an anion exchanger (e.g. Lewatit® MP 62) to quench the polymerization and remove metal ions (Col. 3, lines 56-60 and Col. 8, lines 40-41). Thus, the processes of Kirchmeyer and Hus are expected to have the same or substantially similar advantages, e.g. pot life and conductivity, because both Kirchmeyer and Hus teach a process that comprises of the same or substantially similar components and structurally similar compounds are generally expected to have similar properties. In re Gvurik, 596 F. 2d 1012, 201 USPQ 552.

Based on the above rational, it is believed that the claimed limitations are met by the reference submitted and therefore, the rejection is maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH T. NGUYEN whose telephone number is (571)272-8082. The examiner can normally be reached on Monday-Friday 7:00-4:00 EST PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KTN/
12/09/2008

/DOUGLAS MC GINTY/
Primary Examiner, Art Unit 1796